DETAILED ACTION

Election/Restrictions

1. Newly amended claims 47-53 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The following inventions are present in the amended claims:

Group II, claim(s) 40, 42-43, 45-46, 54-88, drawn to a method of treating a mammal.

Group III, claim(s) 47-53, drawn to a method of inhibiting SGK activity within a mammalian cell.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 47-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The inventions listed as Groups II-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the inventions is administration of a compound of formula I to a mammal. As outlined in the Restriction/Election Requirement of 8/28/2007, Kreighbaum et al (US 4,015,006; IDS Reference AB) teach administration of compounds of formula I (col. 1) administered to dogs (col. 5, lines 10-22). Since the technical feature linking the claims has been taught in the prior art, the technical feature lacks novelty; the inventions of Groups II-III does not constitute a special technical

feature. Accordingly Groups II-III are not so linked to form a single general inventive concept.

Response to Arguments

3. Applicants' arguments, filed 3/17/2008, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

4. Applicant's arguments with respect to the rejection under 35 USC 112, 1st paragraph, scope of enablement rejection, have been fully considered but they are not persuasive:

Claims 40, 42-43, 45-46, 54-55, 64-65, 71, and 77-88 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for inhibition of SGKα activity *in vitro* and for methods to assay markers associated with inflammation, does not reasonably provide enablement for a method to treat (which includes “preventing”) inflammation or to treat any disorder or condition associated with hyperproliferation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicant argues the Examiner’s contention that the current claims encompass methods of preventing a disease or condition is no longer viable in view of the claim amendments. The amendments to the claims are noted; claim 40 has been amended

to recite a method of treating a pre-existing hyperproliferative disorder associated with SGK activity in a mammal; claim 45 is specific to treating a mammal having a pre-existing disorder or condition; and claim 78 is drawn to a method of treating pre-existing inflammation or pre-existing angiogenesis in a mammal. In each of these cases, the definition for “prevention” as a component of the definition of “treating” still remains as an embodiment of the claims. Prevention of more advanced states of the diseases previously discussed is still not considered enabled, such as preventing advanced states of rheumatoid arthritis, psoriatic lesions, osteoarthritis, or preventing cancer tumor metastasis. Additionally, a pre-existing hyperproliferative disorder associated with SGK activity still reads on cancer cells that have not developed to a size that allows diagnosis; prevention of such cancers would still be an embodiment of the claims that is not considered enabled. Therefore, the rejection is maintained.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because of the use of the legalese term "comprise" in the 2nd line. Correction is required. See MPEP § 608.01(b).

This objection is necessitated by the 3/17/2008 amendment to the specification.

Conclusion

7. No claim is allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY P. THOMAS whose telephone number is (571)272-8994. The examiner can normally be reached on Monday-Thursday 6:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy P Thomas/
Examiner, Art Unit 1614

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614